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09/692,601	10/19/2000	Yoshio Miyazaki	7217/62903	7919

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EXAMINER	
CHU, KIM KWOK	

ART UNIT	PAPER NUMBER
2653	8

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/692,601	MIYAZAKI, YOSHIO	
	Examiner	Art Unit	
	Kim-Kwok CHU	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *Pre-Amendment filed on 5/4/01 (paper 5)*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Objections

1. Claim 1 is objected to because of the following informalities:

(a) in claim 1, line 7, the term "in an internal memory" should be changed to --in an internal memory of the recording medium-- as disclosed in the specification, on page 5, lines 3-5 and Fig. 10);

(b) similarly, in claim 1, lines 12 and 16, both terms "said internal memory of said recording means" should be changed to --said internal memory of said recording medium-- respectively as disclosed in the specification, on page 5, lines 3-5 and Fig. 10); and

(c) furthermore, in claim 1, line 12, the term "recording medium said internal memory" should be changed to --recording medium into said internal memory--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> *The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

3. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) as in claim 5, lines 2 and 3, the term "in said control table, the digital audio data is paired with the retrieval information" is not clear because the audio data should not be written in the control table; and

(b) similarly, in claim 6, lines 2 and 3, the term "in said control table, the digital audio data is paired with the retrieval information" is not clear because the audio data should not be written in the control table.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless -*
> *(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*

5. Claim 1 is rejected under 35 U.S.C. § 102(e) as being anticipated by Kawamura et al. (U.S. Patent 6,075,920).

Kawamura teaches a recording apparatus having all of the elements and means recited in claim 1. For example, Kuroda teaches the following:

(a) as in claim 1, reproduction means 5-7 to reproduce digital data from a recording medium 2 recorded with the digital data and with retrieval information (Figs. 1, 3 and 10; column 1, lines 17-20; retrieval information is the subcode such as copyright data);

(b) as in claim 1, recording means 18 for writing the digital data reproduced by the reproduction means 5-7 and the retrieval information (subcode) on a control table in an internal memory (Fig. 1; subcode is recorded as a control/management table in the medium; column 18, lines 59-65);

(c) as in claim 1, a control circuit 33 for searching the control table (TOC table) by using the retrieval information when the digital data from the reproduction means is written by the recording means 18 (Figs. 2 and 3; column 17, lines 45-48);

(d) as in claim 1, the control circuit 33 permits the writing of the digital data recorded on the recording medium 2 into the internal memory of the recording means (medium) when the retrieval information is not already recorded in the control table (Figs. 2, 19 and 20; recording is permitted if the copyright subcode is not presented); and

(e) as in claim 1, for prohibiting the writing of the digital data recorded on the recording medium into the internal memory of the recording means when the retrieval information is already recorded on the control table (Figs. 2, 19 and 20; recording is not permitted if the copyright subcode is presented).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

7. Claims 2-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al. (U.S. Patent 6,075,920) in view of Jones (U.S. Patent 5,581,740) and Takenaka (U.S. Patent 5,943,311).

Kawamura teaches a recording and/or reproducing apparatus very similar to that of the instant invention. For example, Kawamura teaches the following:

(a) as in claim 2, a drive device 5-7 to reproduce digital audio data from a recording medium 2 recorded with the digital audio data (Fig. 1, drive device 6 reproduce audio data);

(b) as in claim 2, a disk drive device 19 written with the digital audio data reproduced from the recording medium 2 by the drive device 22 (Fig. 1);

(c) as in claim 2, a control table containing retrieval information for the recording medium written with the digital

audio data in the disk drive device 19 from among a plurality recording mediums (Fig. 1; the retrieval information is the subcode recorded in recording medium 19 which has a plurality of recording medium/layers; column 7, lines 13-15);

(d) as in claim 2, a control circuit 33 to search the control table (subcode/TOC table of contents) by using the retrieval information when the digital data from the reproduction means 6-7 is written by the recording means 18 (Fig. 2);

(e) as in claim 2, the control circuit 33 permits the writing of digital audio data recorded on the recording medium 2 with the recording means 18 when the retrieval information is not recorded in the control table (Figs. 2, 19 and 20; recording is permitted if the copyright subcode is not presented);

(f) as in claim 2, the control circuit 33 prohibits the writing of digital audio data recorded on recoding medium 2 with the recording means 18 when the retrieval information is already recorded on the control table (Figs. 2, 19 and 20; recording is not permitted if the copyright subcode is presented);

(g) as in claim 3, a display means 34 connected to the control circuit (Fig. 2; computer interface includes a display means);

(h) as in claim 4, when writing the digital audio data reproduced from the recording medium 2 onto the disk drive device 19, the control circuit first compresses the digital audio data

reproduced from the recording medium 2 and writes the compressed digital audio data onto the disk drive device 19 (Fig. 1; audio file is stored in MPEG1 or MPEG2 format; column 13, lines 7-10);

(i) as in claim 5, the control table has data showing a write position of the digital audio data in the hard disk drive (TOC data of the audio includes its position); and

(j) as in claim 6, the control table has character data (TOC data includes titles of the recorded files).

However, Kawamura does not teach the following:

(a) as in claim 2, the disk drive 19 is a hard disk drive; and

(b) as in claims 3 and 6, the display means displays information such as writing is prohibited and other text characters.

Jones teaches the following:

(a) a hard disk drive 24 as a recording medium (Fig. 1); and

Takenaka teaches the following:

(a) a display means which displays information indicating that writing is prohibited (Fig. 2; S3, S4 and S5).

A hard disk drive recording medium having an advantage of fast data recording speed is used as a storage device (buffer) for editing multimedia files. Hence, to copy an audio file from a recording medium, it would have been obvious to one of ordinary

skill in the art to use Jones' hard disk drive as Kawamura's data recording medium, because the hard disk drive can store and edit the audio file with high speed.

During the copying operation of the audio file, copy protection might prohibit the file which is being duplicated. Hence, to inform a user the progress of the copying operation, it would have been obvious to one of ordinary skill in the art to sent an error message such as Takenaka's to Kawamura's computer display means, because the displayed information such "copy prohibited" can remind a user the status of the copying operation.

8. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al. (U.S. Patent 6,075,920) in view of Jones (U.S. Patent 5,581,740) and Takenaka (U.S. Patent 5,943,311) and further in view of Inoue (U.S. Patent 6,011,761).

Kawamura in view of Jones and Takenaka teach a recording and/or reproducing apparatus very similar to that of the instant invention. For example, Kawamura in view of Jones and Takenaka further teaches the following:

(a) as in claim 8, the data on the medium is down-loaded from the hard disk drive device 24 and output (Fig. 1 of Jones).

Since the hard disk drive is used as a multimedia editing means, it would have been obvious to one of ordinary skill in the

art to output the recorded file stored in the hard drive so that the file can be stored on a removable storage means such as a DVD.

However, Kawamura in view of Jones and Takenaka do not teach the following:

(a) as in claims 7 and 8, along with a display by the display means that writing is prohibited, ejects the recording medium from the drive device.

Inoue teaches a disk ejection operation after displaying an error message (Fig. 21; steps S33 and S48).

When the disk copying operation is improper, the disk should be unloaded in order to stop any further recording step. Therefore, when Kawamura's audio copying step is prohibited, it would have been obvious to one of ordinary skill in the art to ejected the recording medium similar to Inoue's disk ejection operation, because the ejected recording medium alerts the user that the recording is not allowed.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kawai et al. (6,678,464) is pertinent because Kawai teaches an information recording system having a warning display means during an improper recording operation.

Komma et al. (6,567,358) is pertinent because Komma teaches an information recording system having a warning display means during an improper recording operation.

Yeo (6,452,885) is pertinent because Yeo teaches a copy protected optical disk.

Yoshizawa (6,335,910) is pertinent because Yoshizawa teaches an information recording system having a warning display means during a recording operation.

Tozaki et al. (5,729,516) is pertinent because Tozaki teaches an information recording system having a warning display means during an improper recording operation.

Ishiwata et al. (4,931,927) is pertinent because Ishiwata teaches a method of constructing and recording a list of recorded data recorded onto a disk.

10. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231 Or faxed to:

(703) 872-904 (for formal communications intended for entry. Or:

(703) 746-6909, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (703) 305-3032 between 9:30 am to 6:00 pm, Monday to Friday.

kc 7/13/04

Kim-Kwok CHU
Examiner AU2653
July 13, 2004

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